

1732

PATENT
Customer No. 22,852
Attorney Docket No. 03063.0396-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John M. Eby et al.

Application No.: 09/749,033

Filed: December 28, 2000

For: SURFACE COVERINGS HAVING A
NATURAL APPEARANCE AND
METHODS TO MAKE A SURFACE
COVERINGS HAVING A NATURAL
APPEARANCE

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)
) Group Art Unit: 1732

)
) Examiner: A. Kuhns

RECEIVED
JUL 23 2001
TC 1700

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)(4)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b)(4), Applicants bring to the attention of the Examiner the following information. This Information Disclosure Statement ("IDS") is being filed before the mailing date of a first Office Action on the merits for the above-referenced application.

Further to the IDS filed on June 29, 2001, this submission brings to the Examiner's attention additional information made of record in on-going litigations. Consequently, this information may be material or relevant to the patentability of the instant claims. See M.P.E.P. 2001.6(c).

Applicants originally received the enclosed letter during license negotiations with a competitor. The letter accompanied an "Aquaflor II" brochure and related materials.

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The brochure and the other materials were duly submitted to the PTO in the pending application. See, IDS filed on December 28, 2000. However, the attached letter was not submitted because (1) it is not prior art; and (2) it is not a "corroborated" claim of anticipation. Accordingly, there was no duty on the Applicants to submit this letter when it was originally received. In view of the allegations of fraud and inequitable conduct made during the aforementioned litigations (See, Pleadings filed with the IDS on June 29, 2001), and in an abundance of caution, however, Applicants hereby submit the attached letter for the Examiner's consideration.

1. The Attached Letter Is Not Prior Art

In *Hebert v. Lisle Corp.*, 99 F.3d 1109 (Fed. Cir. 1996), the Federal Circuit held that there was no duty to submit materials that were not, in fact, prior art. The defendant, Lisle Corp., argued that the patentee committed inequitable conduct by failing to submit a series of self-serving letters written by Lisle Corp., which alleged a wealth of invalidating prior art relating to Mr. Hebert's invention for an improved automotive tool. For instance, one letter stated that "[o]ver the years twelve other inventors had sent in a very similar tool idea." The Federal Circuit held that the failure to submit these letters was *not* inequitable conduct because the letters in question were not, themselves, prior art, and there was no evidence that the disclosures they discussed were prior art.

Similarly, in *Nothorn Telecom, Inc. v. Datapoint Corp.*, the Federal Circuit held that a patentee's failure to submit a device that was admittedly not prior art did not constitute inequitable conduct. 908 F.2d 931 (Fed. Cir. 1990) ("Since the Viatron 21

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device was not prior art, it was not material to patentability. . . . Absent materiality, inequitable conduct for failure to disclose cannot lie.”).

Like the references in *Hebert* and *Northern Telecom*, the attached letter is not, itself, prior art. The letter clearly postdates the critical date of the pending application and, therefore, would not be available to the Examiner as a prior “printed publication” under 35 U.S.C. §§ 102(a), 102(b), or 103. See MPEP § 2128 (defining “printed publication”). Since the letter is not a U.S. patent, it is not available as a prior art reference under 35 U.S.C. § 102(e). See MPEP § 2136. Finally, since the letter does not allege a public use or sale in the *United States*, nor invention by another in the *United States*, it could not be a basis for rejection under 35 U.S.C. §§ 102(a), (b), (f), or (g) or 103. This is true even if the Examiner were to consider “non-prior art evidence” of public knowledge, use, sale, or invention by another prior to the critical date.

2. The Attached Letter Contains, at Best, an Uncorroborated Claim of Anticipation

In *Life Technologies, Inc. v. Clontech Labs., Inc.*, 224 F.3d 1320 (Fed. Cir. 2000), the defendant alleged that the applicants committed inequitable conduct by failing to disclose their knowledge that another party claimed to have invented the claimed subject matter and presented the results at a conference prior to the critical date. The Federal Circuit held that the failure to disclose this information was not inequitable conduct because the information was incomplete, e.g., uncorroborated, and thus immaterial. 224 F.3d at 1327. See also *Newell Window Furnishings, Inc. v. Springs Window Fashions Division, Inc.*, 1999 WL 1077882 at *38 (N.D. Ill.) (holding that “uncorroborated information available to [attorney] was not material to patentability, and

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that [attorney] bore no duty to disclose it in uncorroborated form or to seek corroboration for it."). Like the applicants in *Life Technologies*, in the present case Applicants had no duty to disclose the letter to the Examiner because, at best, the letter, alone or in combination with the brochure and other materials, is merely an uncorroborated claim of anticipation.

Applicants respectfully request that the Examiner consider this document listed on the attached PTO-1449 form and indicate that consideration by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that the disclosed information is material or constitutes "prior art." If the Examiner applies the information as prior art against any claim in the present application and Applicants determine that the information does not constitute "prior art" under United States law, Applicants reserve the right to present to the Patent Office the relevant facts and law regarding the appropriate status of such information.

Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the disclosed information, should it be applied against the claims of the present application.

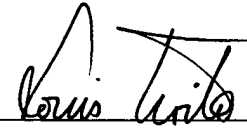
If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: July 18, 2001

By: _____


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